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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,090	10/14/2007	Octavian Schatz	MS143PCTUS	7674

81777	7590	04/28/2011
MorphoSys AG Lena-Christ-Str. 48 Martinsried/Planegg, 82152 GERMANY		

EXAMINER	
CHUNDURU, SURYAPRABHA	

ART UNIT	PAPER NUMBER
1637	

NOTIFICATION DATE	DELIVERY MODE
04/28/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipmailbox@morphosys.com
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Office Action Summary	Application No. 10/587,090	Applicant(s) SCHATZ ET AL.	
	Examiner PRABHA CHUNDURU	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/22/11; 4/12/11</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The response to the office action filed on February 22, 2011 has been considered and acknowledged.

Status of the Application

2. Currently claims 1-13 are pending under examination. Claims 14-67 were cancelled. All the arguments and the amendment have been fully considered and thoroughly reviewed and deemed unpersuasive for the reasons that follow. This action is made FINAL necessitated by IDS with fee.

New Grounds of Rejections necessitated by the IDS

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lexow (WO 01/61036 A2).

Lexow teaches a method for manufacturing of a nucleic acid molecule of claim 1, comprising

a) providing a first at least partially double stranded oligonucleotide comprising a first and a second single stranded overhang (see page 1, line 30-32);

b) providing a second at least partially double stranded oligonucleotide that comprises a first type IIS restriction enzyme recognition site and a modification that allows the oligonucleotide to be coupled to a surface and a single stranded overhang (see page 1, line 34-37, page 2, line 1-11);

c) ligating the first and the second oligonucleotides via the single strand overhangs to form a first ligation product (see page 2, line 13-21);

d) cutting the first ligation product with the type IIS restriction enzyme releasing an elongated first partially double stranded oligonucleotide having a first and second single strand overhang and a truncated second partially double-stranded oligonucleotide (see page 3, line 21-38, page 4, line 1-37, page 5, line 20-38, page 7, line 32-38, page 8, line 1-29, page 11, line 21-36);

e) immobilizing the truncated second partially double-stranded oligonucleotide, the unreacted second partially double-stranded oligonucleotide and/or uncut first ligation product via the modification to a surface and the modification is located I the second overhang (page 8, line 30-36);

f) repeating steps a) to e) (see page 10, line 36-38).

With regard to claim 2-3, Lexow teaches that the first ligation product is immobilized via the long single-strand overhang (see page 8, line 30-36).

With regard to claim 4, Lexow teaches that the method comprises washing the immobilized first ligation product and separating it from the surface (see page 10, line 16-20).

With regard to claim 5-8, Lexow teaches that the first overhang comprises a length of 1, 2, 3, 4, 5, 6 or 7 nucleotides and the first and second overhangs of the first oligonucleotide allows stable hybridization (see page 8, line 17-27, page 7, line 12-16).

With regard to claim 9-11, Lexow teaches that the modification is biotin modification and interaction with the support occurs via biotin modification and the interaction group comprises streptavidin (see page 8, line 30-36).

With regard to claim 12, Lexow teaches that a part of nucleic acid to be manufactured is part of the elongated first partially double stranded oligonucleotide (see page 2, line 13-21, page 7, line 32-37).

With regard to claim 13, Lexow teaches that the steps a) to e) are repeated at least once and the nucleotides transferred from the second and any partially double stranded oligonucleotides provided in step b) to the first oligonucleotide are the nucleic acid to be manufactured or part thereof (see page 11, line 21-36). Accordingly the claims are anticipated.

Response to arguments:

3. With regard to the rejection of claims 13-21 under 35 USC 102(e), the arguments and the amendment were fully considered and found unpersuasive. First, the amendment do not change the scope of the claims since the prior art on the record teach a first oligonucleotide comprising a first and second overhang wherein one overhang comprises a modification and the other overhang participates in ligation. The prior art on page 17, paragraph 0187-0188 clearly teach that the overhangs or transition anchor oligonucleotide sequences are added as overhangs and the ligation product is immobilized to reaction wells via a modification in the transition anchor moiety, which clearly indicate that the overhang sequence which participates in immobilization

comprises a modification. Further as discussed in the rejection, the first oligonucleotide comprises 5' and 3' overhangs and one of which comprises a modification that participates in immobilization of the oligonucleotide to a solid support. Accordingly the claims are anticipated and the rejection is maintained.

Conclusion

No claims are allowable.

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 2/22/11 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Suryaprabha Chunduru/

Primary Examiner, Art Unit 1637